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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,507	10/31/2003	Robert H. Wollenberg	T-6298D (538-63)	3586
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Michael E. Carmen, Esq. M. CARMEN & ASSOCIATES, PLLC Suite 400 170 Old Country Road Mineola, NY 11501				
EXAMINER				
WALLENHORST, MAUREEN				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
11/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/699,507

Applicant(s)

WOLLENBERG ET AL.

Examiner

Maureen M. Wallenhorst

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39-45 and 47-63 is/are allowed.
- 6) ☒ Claim(s) 46, 64-66, 79 and 80 is/are rejected.
- 7) ☒ Claim(s) 64-80 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 14, 2008 has been entered.
2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. Claims 64-80 are objected to because of the following informalities: On line 10 of claim 64, the phrase "in a plurality of test reservoirs" should be changed to --in a plurality of test receptacles-- since many of the claims dependent on independent claim 54 recite "test receptacles". Appropriate correction is required.
4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1797

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 46, 64-66, 79 and 80 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 11-12, 14, 18-19 and 21 of copending Application No. 12/072,364 in view of Kolosov et al (US 2004/0123650). Claims 1, 11-12, 14, 18-19 and 21 of application serial no. 12/072,364 recite a method and system for preparing a plurality of different lubricating oil compositions comprising conducting molecular modeling of at least one base oil of lubricating viscosity and at least one lubricating oil additive to provide leading candidates of the at least one base oil of lubricating viscosity and at least one lubricating oil additive for combination to formulate a leading candidate lubricating oil composition for testing, and containing, under program control, a plurality of leading candidate lubricating oil compositions comprising a major amount of at least one leading base oil of lubricating viscosity candidate and a minor amount of at least one leading lubricating oil additive candidate in varying percentages in a plurality of test receptacles. The claims of application serial no. 12/072,364 also recite heating the at least one leading base oil of lubricating viscosity candidate and the at least one leading lubricating oil additive, recite further analyzing the plurality of leading candidate lubricating oil compositions, and recite that the step of molecular modeling is carried out using a computer molecular modeling program. The claims of application serial no. 12/072,364 fail to recite that the storage stability of each leading candidate lubricating oil composition located within the test receptacles is measured.

Kolosov et al teach of a high throughput testing method and apparatus for the screening of a library of material samples. The method and apparatus involve combinatorial chemistry that refers to the synthesis of a collection of diverse materials, and the screening of the materials for desirable performance characteristics and properties. The combinatorial approach can effectively evaluate much larger numbers of diverse compounds in a much shorter period of time. The apparatus taught by Kolosov et al includes a plurality of samples supported in wells on a substrate. Kolosov et al teach that the invention can be used to screen libraries of any flowable material that may be a commercial product itself or may be a portion of a commercial product. Exemplary commercial products that can be tested with the apparatus taught by Kolosov et al include lubricants and oils. The invention can be used to analyze the resulting properties of a particular flowing material, and to analyze the relative or comparative effects that an additive has upon a particular flowable material. Additives in a flowable material to be tested include a detergent, a flow modifier, etc. See paragraph nos. 0042-0043 in Kolosov et al. The screening for the effects of different additives upon the characteristics of a flowing material is performed by measuring various properties of the material samples present in the wells on the substrate. Properties measured include the viscosity, the density, the thermal degradation, the aging characteristics, the chemical composition and the agglomeration or sedimentation of the material samples. See paragraph no. 0065 in Kolosov et al. Once the characterizing properties of the samples are determined, the results may be mathematically combined in various combinations to provide figures of merit for the properties of interest. See paragraph no. 0066 in Kolosov et al. The sample size of each sample in the wells on the substrate is typically no greater than about 20 ml, more preferably no greater than about 5 ml, and most preferred, no greater than

about 0.5 ml. See paragraph no. 0054 in Kolosov et al. To form an array of samples on the substrate, Kolosov et al teach that the samples and additives are dispensed into the wells with any suitable dispensing apparatus (i.e. an automated micropipette or capillary dispenser). The dispensing apparatus may have a heated tip, thus providing heating of the samples. Each sample is dispensed to an individually addressable region in the substrate. See paragraph no. 0053 in Kolosov et al. The plurality of samples can vary in number depending upon the intended use of the method, and the plurality of samples can form a library. A library comprises an array of two or more different samples spatially separated on a common substrate. Candidate samples within a library may differ in a definable and predefined way, such as in chemical structure, processing, mixtures of interacting components, the relative amounts of the components, the presence of additives and other reactant materials, etc. The samples are spatially separated on the substrate such that an array of samples is separately addressable for characterization thereof. The two or more samples can reside in separate containers formed as wells in a surface of a substrate or can be simply dispensed onto a common planar substrate. See paragraph no. 0057 in Kolosov et al. The apparatus taught by Kolosov et al comprises a stimulus generator 12 that applies power to a probe 14 for applying a stimulus to one or more samples 16 in the array or library of samples. The apparatus also includes a sensor or transducer 20 for monitoring a response of one or more of the samples 16 to the stimulus. The transducer 20 and the stimulus generator 12 are both in communication with a computer sub-system 23 such as a microprocessor or other computer for manipulating data. The computer sub-system 23 may be employed to receive and store data such as responses of samples 16, material properties of samples, etc. Additionally, the computer sub-system may be employed to command other components of the system such as the stimulus

generator and the dispensing means, as well as to correlate responses of samples 16 to their respective material properties. See paragraph nos. 0067-0068 in Kolosov et al. The probe 14 may be translated, rotated, reciprocated or oscillated within the samples so as to mix the samples and subject them to different forces. See paragraph no. 0070 in Kolosov et al. For contacting the probe 14 and dispensing means with the samples 16, the samples may be moved relative to the probe 14, or alternatively, the probe 14 may be moved relative to the samples 16. Combinations of these motions may also occur serially or simultaneously. An automated system may be used to move the one or more probes and the dispensing means serially or simultaneously to the various samples of a library. A suitable automated system is a robotic system such as an XYZ robot arm that has a multiple axis range of motion such as in the orthogonal X, Y, and Z coordinate axes system. This automated system is part of or in communication with the computer sub-system 23. See paragraph nos. 0073-0074 in Kolosov et al. Kolosov et al also teach that a plurality of control samples having known material properties are also monitored in the libraries along with the samples so that the responses of the samples can be compared with the known material properties of the controls. The responses of the samples in the library can be related to the known material properties by a mathematical relationship. Kolosov also teach that a parameter of a sample can be measured at a first time followed by measuring the parameter at a second time and so on during a predetermined period of time. Kolosov teach that one or more processes may be occurring on the samples during this predetermined period of time, and these processes may affect or change the parameter or property of the samples over time. Monitoring may be performed to determine if a particular process has any effect at all on a sample. See paragraph 0096 in Kolosov et al. Kolosov et al also disclose that the temperature of the samples

can be elevated once dispensed into the substrate. See claims 22 and 39 in Kolosov et al. This elevation in temperature can be considered a process that may affect the properties or parameters of the sample over time.

Based upon the combination of claims 1, 11-12, 14, 18-19 and 21 in application serial no. 12/072,364 and Kolosov et al, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to measure the storage stability of each leading candidate lubricating oil composition located within the test receptacles recited in the claims of application serial no. 12/072,364 since Kolosov et al teach that it is advantageous to screen lubricating oil composition samples located within a combinatorial library or array by measuring storage stability parameters such as viscosity, sedimentation, density, thermal degradation, aging characteristics, etc. in order to evaluate the effectiveness of the lubricating oil compositions for their intended purpose.

This is a provisional obviousness-type double patenting rejection.

6. Claims 67-78 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. Claims 39-45 and 47-63 are allowable over the prior art of record since none of the prior art of record teaches or fairly suggests a method and system for preparing and screening a plurality of different lubricating oil compositions comprising the steps of conducting molecular modeling of at least one base oil of lubricating viscosity and at least one lubricating oil additive to provide leading candidates of the at least one base oil and at least one oil additive for combination to formulate a leading candidate lubricating oil composition for testing, containing a plurality of the leading candidate lubricating oil compositions containing a major amount of at

least one leading base oil of lubricating viscosity candidate and a minor amount of at least one leading lubricating oil additive candidate in varying percentages in a plurality of test reservoirs, and measuring the storage stability of the plurality of leading candidate lubricating oil compositions.

8. Applicant's arguments filed November 14, 2008 have been fully considered but they are not persuasive.

The previous rejections of the claims made in the last Office action mailed on August 11, 2008 under 35 USC 103 as being obvious over the combination of references to Kolosov et al, O'Rear, the Condensed Chemical Dictionary, Tolvanen et al and Garr et al have been withdrawn in view of the amendments made to the claims. As noted above, claims 39-45, 47-63 and 67-78 are allowable over the prior art of record. All of the pending claims in this application would be allowable upon the filing of a terminal disclaimer over related application serial no. 12/072,364.

Art Unit: 1797

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maureen M. Wallenhorst whose telephone number is 571-272-1266. The examiner can normally be reached on Monday-Wednesday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden, can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maureen M. Wallenhorst
Primary Examiner
Art Unit 1797

mmw

November 18, 2008

/Maureen M. Wallenhorst/

Primary Examiner, Art Unit 1797